

## REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and these comments.

Claims 5 and 9 are currently amended to correct inadvertent errors and more clearly recite the claimed invention. Support for the amended claims is found in the specification, for example, at paragraphs [0037] - [0044] of the published version of the application. Since no new matter is introduced, entry of the revisions is requested. Upon entry, claim 5, 6, and 8-10 are pending in the instant application.

### **I. Claim Rejections-35 USC § 112, second paragraph**

Claims 5, 6, 8-10 stand rejected for alleged indefiniteness for failing to “particularly point out and distinctly claim” the present invention. Office Action, pages 2 and 3, section 2.

Without acquiescing to this rationale for rejection, applicants have opted to advance prosecution by amending claims 5 and 9. Specifically, claim 5 and claim 9 (steps b, e, and f) are amended to provide additional clarity as required by the examiner.

The pending action also faults claim 9 (step d) for allegedly failing to define the variable “n.” As discussed in MPEP § 2163(I)(B), however, there is no *in haec verba* requirement for claim limitations. Instead, claim limitations only need to be supported in the specification “through express, implicit, or inherent disclosure.” In other words, claim language need not appear verbatim in the specification, so long as one of ordinary skill in the art would understand that the newly added claim language was expressly or implicitly covered in the original disclosure, *i.e.*, as long as the original disclosure conveys to the skilled artisan that the applicants had possession of the subject matter at issue.

Accordingly, paragraphs [0037], [0039] and [0040] teach equations used to determine a “mean value” at various steps of the claimed method. Moreover, the variable “n” is expressed as the denominator of the equations. A skilled artisan therefore would understand that the equations taught in the specification determine a “mean value,” which represent the sum of all values in a particular group (numerator) divided by the total number of values in a particular group (denominator), herein represented by “n.” Accordingly, applicants submit that a person of skill

in the art would immediately recognize the variable, “n,” as recited in claim 9 (step d), to represent the total number of candidate molecules for which the calibrated mass value is calculated.

In light of the foregoing, applicants submit that the stated grounds for “indefiniteness” rejection are inapposite to the present claims. Withdrawal of these rejections is requested, therefore.

## **II. Claim Rejections-35 USC § 112, first paragraph**

Claims 5, 6, 8-10 stand rejected for allegedly failing to enable the claimed invention, and for introducing new matter not supported by the specification. Particularly, the examiner alleges the specification fails to support “inputting of any data into a computer” and “inputting known mass values for at least two candidate molecules.” Office Action, page 4, sections 3 and 4.

In contrast to the examiner’s allegations in section 3 of the pending action, paragraph [0044] teaches that the claimed method “can be rendered into desired computer program” and that “the program can be executed on a desired computer system or a computer network.” However, to promote prosecution of the instant application, and not in acquiescence to the examiner’s rejections, applicants have amended claim 9 to provide additional clarity. Additionally, claim 9 is amended to remove mention of “at least two candidate molecules.” The examiner’s non-enablement and lack-of-written-description rejections are now moot, therefore, and applicants request they be withdrawn.

## **III. Claim Rejections-35 USC § 101**

Claims 5, 6, and 8-10 stand rejected for allegedly encompassing non-statutory subject matter. The examiner states in section 5 of the pending action that the present claims are drawn to a “computational method” and fails to embody a statutory process, which must include either a final resulting step of “physical transformation” or be directly “tied to a particular machine” accordingly to *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008).

While not in acquiescence to the examiner’s stated rationale, but solely to advance prosecution of the pending application, claim 9 is revised to comport with the “machine” prong of *Bilski*. According to claim 9, that is, each step of the inventive biopolymer identification

methodology is "performed using a computing device." In this fashion the inventive methodology, as claimed, is "tied to a particular machine" and, hence, meets a *Bilski* standard for statutory subject matter. Accordingly, applicants request the examiner's rejection under section 101 be withdrawn.

### CONCLUSION

Applicants submit that this application is in condition for allowance, and they request an early indication to this effect. Examiner Borin is invited to contact the undersigned directly, should he feel that any issue warrants further consideration.

Respectfully submitted,

Date 16 June 2009

By S. A. Bent

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5404  
Facsimile: (202) 672-5399

Stephen A. Bent  
Attorney for Applicants  
Registration No. 29,768

**The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, then applicants hereby petition for such extension under 37 CFR §1.136 and authorize payment of the relevant fee(s) from the deposit account.**